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Date: 5/1/06

By: Patti Hespell  
Patti Hespell

**Mail Stop Issue Fee**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In Re: Patent Application of Jeffrey S. Hamilton**

Conf. No.: 8779 : Group Art Unit: 2613  
Appln. No.: 09/694,848 : Examiner: Rekstad, Erick J.  
Filing Date: 20 October 2000 : Att'y. Docket No.: T712-10

Title: Method and Apparatus for Inserting Digital Media Advertisement into  
Statistical Multiplexed Streams

**APPLICANT'S COMMENTS ON STATEMENT OF REASONS FOR**

**ALLOWANCE UNDER 37 CFR 1.104(e)**

Responsive to the Examiner's Statement of Reasons for Allowance, included with the Notice of Allowance dated March 21, 2006, and concurrent with payment of the Issue Fee in the above-identified patent application, please consider the following remarks:

### REMARKS

The following Remarks are made with respect to the Examiner's Statement of Reasons for Allowance ("Statement"), at pages 2-3 of the Notice of Allowability.

Rule 1.104(e) and MPEP 1302.14 permit the Examiner to set forth a written statement of reasons for allowance under certain circumstances. MPEP 1302.14 expressly provides that "(t)he statement is not intended to necessarily state all the reasons for allowance or all the details why claims are allowed and should not be written to specifically or impliedly state that all the reasons for allowance are set forth." While the Examiner's Statement sets forth at least one reason for allowance, Applicant expressly reserves the right to assert in any future proceedings regarding this application or any patent(s) issuing directly or indirectly therefrom, the allowability and/or allowance of the claim(s) on the basis of any other reason(s) consistent with the prosecution history of the application.

Additionally, certain requirements for the statement of reason(s) are expressly set forth in MPEP 1302.14, including the requirement that, "each statement should include at least (1) the major difference in the claims not found in the prior art of record, and (2) the reasons why that difference is considered to define patentability over the prior art if either of these reasons for allowance is not clear in the record" (emphasis added). The Statement of reason(s) with respect to all of the claims is traversed at least on the ground that it fails to comply with the aforesaid requirement of MPEP 1302.14. Applicant respectfully submits that the Examiner's Statement has not explained reasons why the differences identified by the Examiner between the allowed claims and the prior art are considered to define patentability over the prior art. That is, the Examiner's Statement does not provide any explanation with respect to U.S. Patent No. 6,611,624 to Zang *et al.*, other than repeating verbatim portions of the text of the independent claims. Thus, the Statement fails to satisfy express provisions of the MPEP.

Additionally, Rule 1.104(e) limits the Examiners' ability to provide a statement of reasons for allowance to some degree. The rule states, in pertinent part:

If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the Examiner may set forth such reasoning.

Consequently, where the statement of reason(s) does not clarify the reason(s) for allowance over the prosecution record (or actually further confuses the record), the statement violates Rule 1.104(e). As noted above, the Examiner's Statement is not clear with respect to why the claimed features or elements the Examiner considers to be the major difference(s) that are not found in the prior art of record define patentability. Thus, the Examiner's Statement does not further clarify the record. Accordingly, since the Examiner's Statement violates Rule 1.104(e), it is of no legal effect.

For the foregoing reasons, Applicant therefore denies acquiescence to such Statement and further denies being bound by any negative inferences that may flow therefrom in any future proceedings regarding this application or any patent(s) issuing directly or indirectly therefrom.

Respectfully submitted,

Date: 5/1/06

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